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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:

Inventor(s) : Tsang, et al
Filed : 10/11/2000
Serial No. : 09/686,120
Confirmation No. : 4933
Group Art Unit : 2611
Examiner : Saltarelli, Dominic D.
Docket Number : SNY-P3965
Title : IP Address Discovery for Cable Modem in Set Top Box

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST TO RESTART PERIOD FOR RESPONSE, AND
REQUEST TO REMOVE THE FINALITY OF THE OUTSTANDING OFFICE ACTION

Sir:

Request to Restart the Period for Response

Applicant hereby requests that the period for response to the outstanding Office Action dated October 18, 2005 be restarted. While PAIR and the Office Action itself indicates a mailing date of October 18, 2005, the Office Action was apparently not mailed until October 26, 2005 as evidenced by the attached copy of the envelope in which the Office Action was mailed.

Request to Remove the Finality of the Current Final Rejection

Applicant further requests that the finality of the current Office Action be removed on the grounds that the Final Rejection is premature under MPEP 706.07. The current Office Action dated October 18, 2005 gives no reason as to why the rejection is made final. The prior Office Action dated July 15, 2005 indicates that the new grounds for rejection was necessitated by Applicant's amendment. This issue was not previously raised since Applicant chose to file Notice of Appeal with a Request for a Pre-Appeal Brief Request for Review (which was apparently never carried out).

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Applicant submits that the finality is premature since claims 90 and 91 are identical to originally submitted claims 32 and 34. Claim 90 is identically claim 32 rewritten in independent form, and claim 91 is identically original claim 34. These claims were separately presented due to the desire to retain their original content while amending the original claims (and thus the claims dependent therefrom). The fact that these claims are identical to those originally presented was brought to the Examiner's attention in the response filed February 28, 2005 at pages 17 and reiterated at page 19.

The first Office Action dated December 17, 2004 rejected claim 32 based on the combination of Liu and Lim of record, and further rejected claim 34 based on the combination of Liu, Lim, Koperda and Rahamim of record.

Bearing in mind that claim 32 is now claim 90 and claim 34 is now claim 91, Applicant notes that the second (and Final) Office Action dated July 15, 2005 rejected claims 90 on the basis of the combination of Lim and Liu in view of Slezak of record. This Office Action also rejected claim 91 on the basis of the combination of Lim, Slezak, DeBettencourt, Caputo, Blumenau, Koperda, Bernardini, and Rahamim (a total of eight references!).

At this time, claims 90 and 91 still remain unamended in substance from the original claims 32 and 34. Claim 90 is rejected in the Office Action dated October 18, 2005 on the basis of the combination of Lim, DOCSIS, DHCP and Slezak of record. Claim 91 stands rejected on the basis of the **COMBINATION OF TEN REFERENCES - Lim, DOCSIS, DHCP, Slezak, DeBettencourt, Caputo, Blumenau, Koperda, Bernardini, and Rahamim.**

Thus, original claims 32 and 34, which are current claims 90 and 91 have now been rejected on three separate grounds in three separate Office Actions without any substantive amendment. Clearly no action of Applicant necessitated any of the new grounds for rejection. Accordingly, removal of the finality of the current rejection is requested.

Concluding Remarks

In view of the above remarks, the undersigned submits that it is appropriate to restart the period for response in the Office Action dated October 18, 2005 and to remove the finality of this Office Action. This submission is not intended to be a full response to the current Office Action,

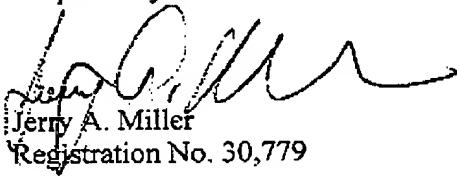
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but merely addresses petitionable matters which the undersigned wishes to address at the earliest possible time. Further, this submission is not intended to be a petition, but a request of the Examiner in hopes of avoiding the necessity of a petition.

If the Examiner has questions regarding this submission, the undersigned invites a telephone call at the telephone number listed below.

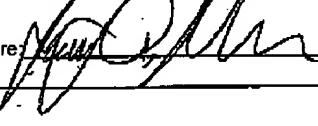
Respectfully submitted,



Jerry A. Miller
Registration No. 30,779

Dated: 10/28/2005

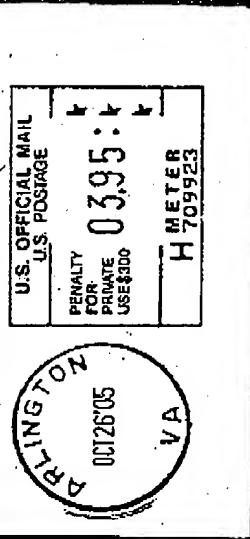
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